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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: :
: Confirmation No. 2731
KIRK BINGEMAN, ET AL. :
: Group Art Unit 3621
Serial No.: 09/626,648 :
: Examiner: Mary Da Zhi Wang Cheung
Filed: 07/27/2000 :

Title: METHOD AND APPARATUS FOR CONTINUING PLAY WITH
CART-BASED NAVIGATION/INFORMATION SYSTEM DISPLAY

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL OF APPELLANT'S BRIEF

1. Transmitted herewith are three copies of Appellant's Brief on Appeal, each copy consisting of 21 pages.
2. Each of Appellant and assignee of the application on appeal is a small entity. Enclosed herewith is a completed Credit Card Payment Form (PTO-2038) to cover the small entity fee of \$170.00 for filing this Appeal Brief. A duplicate copy of this transmittal letter is enclosed.

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Dated: 11/29/2004



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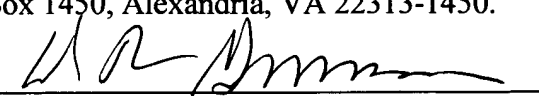
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APPELLANT'S BRIEF (37 CFR § 41.37)

This brief is filed pursuant to the Notice of Appeal filed 09/29/2004, in response to the decision of the primary examiner dated 06/29/2004 (the "Final Action"), finally rejecting claims 1-11, the only claims in this application. The fees required under 37 CFR § 41.20(b)(2) for filing the brief are dealt with in the accompanying Appeal Brief Transmittal.

This brief contains the following items under the headings and in the order set forth below (37 CFR §41.37(c)(1)):

- (i) Real party in interest
- (ii) Related appeals and interferences
- (iii) Status of claims
- (iv) Status of amendments
- (v) Summary of claimed subject matter
- (vi) Grounds of rejection
- (vii) Argument
- (viii) Claims appendix
- (ix) Evidence appendix
- (x) Related proceedings appendix

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(i) Real party in interest

The real party in interest in this appeal is ProLink/ParView, LLC, exclusive licensee of the assignee of the application which is the subject of this appeal.

(ii) Related appeals and interferences

None.

(iii) Status of claims

Claims 1-11, the only claims present in this application, stand rejected in the Final Action and are the claims being appealed in this proceeding. The claims as they were presented at the time of final rejection are set forth in section (viii) Claims appendix, of this Brief.

Independent claims 1 and 7 of original claims 1-9 were amended to overcome a rejection under Section 112, second paragraph, in the first Office Action. Independent claims 10 and 11 were added after the first Action.

(iv) Status of amendments

No amendment has been filed subsequent to the final rejection in this application.

(v) Summary of claimed subject matter

Appellant's invention resides in providing a golfer commencing to play a round of golf and who may consider doing so using an unfamiliar cart-based golf course navigation and information system, the opportunity to learn some of the basic advantages of such a system in playing the course by accepting a gratis trial period at the outset of play. Rather than being required to make the decision to bear the cost of the cart-based system "sight unseen" for a full round of play, or to forgo its use and be assigned a cart with system graphics or display rendered inactive, the golfer can try the system out at no cost for a few holes, and then make a decision.

As stated at page 4 of appellant's specification, a principal objective of the present invention is to provide a method and apparatus which gives the player a reasonable but limited opportunity to evaluate such a system during play of the course, and to then make an informed decision by the time a specified point in play of the round is reached, of whether or not to continue using the system to complete the round. If the golfer finds the system to be to his or her liking, a commitment to payment for its use is made; otherwise no commitment of payment need be made and the system is automatically shut down with no fee incurred by the golfer for its

earlier use and no other disablement of the cart.

An aspect of the invention involves a method (claim 1) for administering use of a golf course information system (page 1, line 18 - page 3, line 11) implemented in golf carts (page 2, lines 13-21; 15, FIG. 1B) or other roving units with display monitor (14, FIG. 1B) adapted to provide display of any or all information from among course and hole layout (FIG. 1A), course features and distance to assist a golfer in play of the golf course (10, FIG. 1A), or of specific interest to the individual golfer from external networks including tournament and individual scoring, stock quotations and email (page 5, lines 4-8). The method includes invoking a gratis trial period less than an entire round of play of the course (page 9, lines 11-20; e.g., the first two holes 12 and 13, FIG. 1A) during which the cart display of such information is activated for a golfer commencing use of the cart (page 9, lines 13-14; 27, 28, FIG. 3); and automatically rendering the cart display of such information inactive at the end of the gratis trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made by a golfer using the cart (page 9, line 19 - page 10, line 8; 29, 30, 31, 32, FIG. 3).

Providing the golfer with a capability to enter a payment authorization during or at the end of the gratis trial period (claim 2; page 10, lines 9-13; page 11, lines 16-21) is achieved by outfitting the cart with that capability (claim 3; page 11, lines 18-20; page 14, lines 5-7; 17, FIG. 2A; 18, FIG. 2B; 19, FIG. 2C), or by locating a kiosk (claim 4; 16, FIGS. 1A, 1C) outfitted with that capability at a point of play to be traversed by the cart during or at the end of the gratis trial period (page 11, lines 18-20; page 14, lines 7-14). The capability may be provided (claim 5; page 15, line 18 - page 16, line 1) by at least one of a credit, debit or smart card reader, a paper currency reader, a keypad, a touch sensitive screen, an optical scanner, a magnetic scanner, or a wireless communicator (page 5, line 16 - page 6, line 4; page 8, lines 1-4; page 15, line 20 - page 16, line 9; 16, FIG. 1C; 17, FIG. 2A; 18, FIG. 2B; 19, FIG. 2C).

A variation of the invention is a method (claim 6) for administering use of a golf course information system (page 1, line 18 - page 3, line 11) implemented in golf carts (page 2, lines 13-21; 15, FIG. 1B) or other roving units with display monitor (14, FIG. 1B) adapted to provide display of any or all information from among course and hole layout, course features and distance (FIG. 1A) to assist a golfer in play of the golf course (10, FIG. 1A), or of specific interest to the individual from external networks including tournament and individual scoring, stock quotations and email (page 5, lines 4-8). This method includes establishing a gratis trial period less than an entire round of play of the course (page 9, lines 11-20; e.g., the first two holes 12 and 13, FIG.

1A) during which the cart display of such information is enabled for a golfer using the cart (page 9, lines 13-14; 27, 28, FIG. 3); and disabling the cart display of such information at the end of the gratis trial period unless, by that point of play, an act representing commitment of payment for completion of the round with enabled cart display has been detected (page 9, line 19 - page 10, line 8; 29, 30, 31, 32, FIG. 3).

Another variation of the invention is a method (claim 7) for administering use of a golf course information system (page 1, line 18 - page 3, line 11) implemented in golf carts or other roving units (page 2, lines 13-21; 15, FIG. 1B) with display monitor (14, FIG. 1B) adapted to provide display of any or all information from among course and hole layout, course features and distance (FIG. 1A) to assist a golfer in play of the golf course (10, FIG. 1A), or of specific interest to the individual from external networks including tournament and individual scoring, stock quotations and email (page 5, lines 4-8). This method includes invoking a gratis trial period less than an entire round of play of the course (page 9, lines 11-20; e.g., the first two holes 12 and 13, FIG. 1A) during which the cart display of such information is activated for a golfer commencing use of the cart (page 9, lines 13-14; 27, 28, FIG. 3); and automatically maintaining the cart display of such information active for completion of the round if, by the end of the gratis trial period, a commitment of payment therefor has been made by a golfer using the cart (page 11, lines 5 - 21; 29, 30, 31, 32, FIG. 3).

Still another variation of the invention is a method (claim 8) for administering use of an information system (page 1, line 18 - page 3, line 11) implemented in golf carts (page 2, lines 13-21; 15, FIG. 1B) adapted to provide access to information available through the system to golfers using the carts during play of a golf course (10, FIG. 1A). The method includes establishing a trial period at the start of play with a cart, less than an entire round of play of the golf course (page 9, lines 11-20; e.g., the first two holes 12 and 13, FIG. 1A), during which at least the bulk of the information is available for access by the cart user (page 12, lines 11-16), and ending access to the available information by the cart user at the end of the trial period absent a payment authorization for continued access during play of the round (page 9, line 19 - page 10, line 8; page 12, lines 16-17; 29, 30, 31, 32, FIG. 3).

Another aspect of the invention resides in apparatus (claim 9) for administering use of an information system (page 1, line 18 - page 3, line 11) implemented in golf carts (page 2, lines 13-21; 15, FIG. 1B) adapted to provide access to information available through said system to golfers using the carts during play of a golf course (10, FIG. 1A). The apparatus includes a cart-implemented information system (page 13, lines 9-21; 14, FIG. 1B) that automatically establishes

a trial period at the start of play of a round of golf with a cart on the golf course, less than an entire round, during which substantially all of the information is available for access by the cart user (page 12, line 18 - page 13, line 2; 27, 28, FIG. 3), and entry means for detecting payment authorization by the end of the trial period for enabling continued access to said available information beyond the end of the trial period (page 7, lines 12-14; page 11, lines 16-21; page 12, lines 1-8; page 13, lines 3-4; page 14, line 5 -page 15, line 2; 16, FIGS. 1A, 1C; 17, FIG. 2A; 18, FIG. 2B; 19, FIG. 2C).

Another aspect of the invention resides in a method (claim 10) of controlling the availability of information presented to a user of a golf course mobile navigation system (page 1, line 18 - page 3, line 11) from within the system during play of the course (10, FIG. 1A), wherein at least some of the information is presented relative to the real-time position of the system as it traverses the course (page 2, lines 2-21; page 4, line 20 - page 5, line 4), to enhance play. The method includes providing a gratis trial period for full availability of the information to the user on commencing use of the system, less than an entire round of play of the course (page 9, lines 11-20; page 12, lines 14-16; e.g., the first two holes 12 and 13, FIG. 1A; 26, 27, 28, 29, FIG. 3), and automatically curtailing the amount of said information available to the user at the end of said trial period, unless payment authorization is given for continued full availability thereafter (page 7, lines 4-9; page 12, lines 16-17) .

Still another aspect of the invention resides in apparatus (claim 11) for controlling the availability of information presented to a user of a golf course mobile navigation system (page 1, line 18 - page 3, line 11) from within the system during play of the course (10, FIG. 1A), wherein at least some of said information is presented relative to the real-time position of the system as it traverses the course (page 2, lines 2-21; page 4, line 20 - page 5, line 4), to enhance play. The apparatus includes means adapted to implement a trial period for full availability of the information to the user on commencing use of the system, less than an entire round of play of the course (page 9, lines 11-20; page 12, lines 14-16, line 18 - page 13, line 2; e.g., the first two holes 12 and 13, FIG. 1A; 26, 27, 28, 29, FIG. 3), and means responsive to completion of the trial period without a commitment to pay for continued full availability of the information in further play of the round, for automatically curtailing the amount of information available to the user from the system thereafter (page 7, lines 4-9; page 13, lines 2-4; page 15, lines 13-18; 11, FIG. 1A).

(vi) Grounds of rejection to be reviewed on appeal

(1) Claims 1-7 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,507,485 (Fisher) in view of US 5,319,548 (Germain) in further view of US 6,317,718 (Fano) [first paragraph of section 5 on page 3 of the Final Action].

In essence, the examiner asserts as part of this ground of rejection of independent claim 1, that Fisher teaches what is set forth in the preamble of claim 1 [paragraph of section 5 bridging pages 3 and 4 of the Final Action], but that “Fisher does not specifically teach” either of the two steps recited as the claimed method (invoking a gratis trial period ..., and automatically rendering the cart display of such information inactive at the end of the gratis trial period unless ... a payment authorization for completion of the round with activated cart display has been made ...) [first sentence of first full paragraph of section 5 on page 4 of the Final Action].

The examiner further asserts, as part of this ground of rejection, that “similar matter [to that of the two steps of the claimed method?] is taught by Germain as a golf course information system sets up [sic] account information for each golfer, each golfer is required to have sufficient payment or payment authorization for playing golf” (citing column 11, line 13 - column 12, line 23 and Figs. 6-7 of Germain in support of this assertion) [second sentence of first full paragraph of section 5 on page 4 of the Final Action].

The examiner goes on to acknowledge, also as part of this ground of rejection, that “Germain does not specifically teach providing a gratis trial period ,, for the player” [third sentence of first full paragraph of section 5 on page 4 of the Final Action] but, nevertheless, states that “it would have been obvious to one of ordinary [sic, skill] in the art to allow the Germain [sic, system?] to provide a gratis trial period less than an entire round of play of the course for each golfer because it would attract more golfers to use the system” [fourth sentence of first full paragraph of section 5 on page 4 of the Final Action].

The examiner further asserts, with respect to this ground of rejection of claim 1: “It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the Fisher [sic, reference?] to include a gratis trial period for each golfer, and after the trial period, the golf [sic, golfer?] require [sic, be required?] to pay for using the system as taught by the modified method of Germain because it would attract more golfers to use this golf course system, and it would also [sic, be?] easier for the owner of the golf course system to collect money from the golfers for using the system” [last sentence of first full paragraph of section 5 on page 4 of the Final Action].

Completing this ground of rejection of claim 1, the examiner asserts that “it would have been obvious ... to allow the method of Fisher modified by Germain to include the feature of

receiving stock quotations and email for external networks [as taught by Fano?] so that the golfers would not miss important information while playing golf" [first paragraph of section 5 on page 5 of the Final Action].

As the ground of rejection of dependent claim 2, the examiner asserts that "the method of Fisher modified by Germain teaches providing the golfer with a capability to enter a payment authorization during or at the end of said gratis trial period" (citing column 11, line 13 - column 12, line 23 and Figs. 6-7 of Germain in support of this assertion) [second paragraph of section 5 on page 5 of the Final Action].

As the ground of rejection of dependent claim 3, the examiner asserts that "the method of Fisher modified by Germain teaches providing a capability to enter payment authorization comprises outfitting the cart with said capability" (citing Fisher column 5, lines 52-54, and Germain column 11, line 13 - column 12, line 23 and Figs. 6-7, in support of this assertion) [third paragraph of section 5 on page 5 of the Final Action].

As the ground of rejection of dependent claim 4, the examiner asserts that "the method of Fisher modified by Germain teaches providing a capability to enter payment authorization comprises locating a kiosk outfitted with said capability at point of play to be traversed by the cart during or at the end of said gratis trial period" (citing Fisher column 5, lines 52-54, and Germain column 11, line 13 - column 12, line 23 and Figs. 6-7, in support of this assertion) [last paragraph of section 5 on page 5 of the Final Action].

As the ground of rejection of dependent claim 5, the examiner asserts that "the method of Fisher modified by Germain teaches said capability comprises at least one of a credit, debit or smart card reader, a paper currency reader, a key pad, a touch sensitive screen, an optical scanner, a magnetic scanner, and a wireless communicator" (citing Germain column 11, line 13 - column 12, line 23 and Figs. 6-7 of Germain in support of this assertion) [first paragraph of section 5 on page 6 of the Final Action].

Claims 6-7 stand "rejected for the similar reason as claim 1" [second paragraph of section 5 on page 6 of the Final Action].

(2) Claims 8-11 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Fisher in view of Germain. [first paragraph of section 6 on page 6 of the Final Action].

As grounds for this rejection, the examiner asserts that "as to claims 8-11, all the limitations are taught by Fisher modified by Germain as discussed in claim 1" [second paragraph of section 6 on page 6 of the Final Action].

(vii) Argument

The statutory provision mandating that obviousness be determined at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains, has been interpreted to impose the test set forth by the U.S. Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Further, MPEP §706.02(j) states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there *must be some suggestion or motivation*, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, *to modify the reference or to combine reference teachings*. Second, there must be a *reasonable expectation of success*. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations*. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added].

It is submitted that the examiner has not met this burden in arriving at the rejections set forth in the Final Action, for the following reasons.

(1) Final rejection of claims 1-7 under 35 U.S.C. 103(a).

(i) With respect to claim 1

First, the examiner acknowledges in the statement of rejection of appellant's independent claim 1, on which claims 2-5 are dependent, that “Fisher does not specifically teach invoking a gratis trial period ... during which the cart display of ... information is activated ..., and automatically rendering the cart display ... inactive at the end of the gratis trial period unless, by that point of play, a payment authorization has been made by a golfer using the cart.” With all due respect, appellant submits the error in that acknowledgment is that Fisher not only does not *specifically* teach invoking a gratis trial period, or automatically rendering the cart display inactive -- Fisher doesn't teach either of those steps of appellant's method in even the most obtuse interpretation of that reference. Fisher doesn't suggest it, nor even hint at it. To put it bluntly, Fisher is completely silent at the point of departure of appellant's invention *as disclosed in the specification and claimed in claim 1* (and each of its dependent claims 2-5).

Appellant is willing to concede that Fisher (not to mention many other sources that might have been cited for the same purpose) generally discloses a golf course information system implemented in golf carts with a monitor adapted to display information from among course and hole layout, course features and distance to assist a golfer in play of the golf course, of the general type recited in the preamble of claim 1. But that recital is merely intended by appellant to set

forth the environment in which the method of the invention claimed in claim 1 (and each of its dependent claims 2-5) is used.

It is submitted that the examiner's reliance on Germain, however, lacks any reasonable basis, either in any rational combination with Fisher or by itself. The examiner states, as part of the rejection: "However, the similar matter is taught by Germain as a golf course information system sets up account information for each golfer, each golfer is required to have sufficient payment or payment authorization for playing golf." Neither that assertion, nor the portion of Germain's specification cited in support of it (column 11, line 13 - column 12, line 23 and Figs. 6-7 of Germain), teaches or suggests appellant's invention, alone or in combination with Fisher's disclosure. It is assumed that in the context the examiner refers to "the similar matter," it is intended to mean similar to the limitations of "invoking a gratis trial period less than an entire round of play of the course during which the cart display of [the previously recited] information is activated for a golfer commencing use of the cart; and automatically rendering said cart display of such information inactive at the end of said gratis trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made by a golfer using the cart" (claim 1).

Before looking at what is actually stated in Germain's col. 11, line 13 -col. 12, line 23 (which refers to Figs. 6 and 7 of that reference), it is useful to review the larger picture of Germain's disclosure. Germain's "Abstract" briefly describes:

"...an interactive golf game information system that receives, stores, analyzes and outputs a plurality of different types of information related to golf. The system generates a golf play recording card for every hole on a golf course for a golfer to record information on his and companions' play of each hole, and for use to display information on how previous rounds of golf on the same course were played or to provide system recommendations concerning play. After the round is completed, the golfer-recorded cards may be inserted into the system for reading and processing the recorded information and compiling statistical information to analyze the golfer's performance."

Under the heading "Field of the Invention," Germain states that the invention:

"relates to an interactive system for receiving, storing, analyzing and outputting information concerning the game of golf, and, more particularly, to an interactive golf information system that can read marks recorded on a golf play recording card and generate golf play statistics and analysis based on the marks that are read."

Under the heading "Relevant Background," Germain briefly discusses the prior art,

including a third party disclosure in which the data recorded on a scorecard provides information for a computer system to develop statistical information on a hole-by-hole basis or club-by-club basis for flight, distance, swing and positioning information, to be used by golfers to evaluate their play.

In the "Summary of the Invention," Germain states several objects of the invention, principally to provide an interactive golf information system for compiling and analyzing golf play based on information recorded on a golf play recording card. In the same section, that golf information system is summarized as:

"... including a CPU with a user interface having a display device and an input device, that allows direct accessing of the system by the golfer in club house, or indirect accessing using a remote device. A user selection menu on the display allows the golfer to select a variety of system operating modes, including, if not ready to play, paying a transaction cost, reserving a tee time, generating a printed lesson based on previous rounds of golf played, printing or displaying a previously played round of golf, statistical analysis and information on a previous round or rounds of golf, league information, handicap, course conditions, information on other golfers and information on other golf courses; or, if ready to play, paying for the round of golf and use of the golf information system, customizing the recording cards and generating the cards, which are pocket-sized and provided for each hole. After the round is played, information recorded by the golfer on each card is input to the system as previously described, and the golfer selects any of various menu options on the display."

Finally, looking at the "Detailed Description" of operation of Germain's interactive golf game information system in cols. 11 and 12 (initially referencing a flow chart of Fig. 6, and subsequently, of Fig. 7), which examiner cites as supporting her analysis and the rejection, the specification states, in relevant part:

"If a golfer has not used the system before, account information and a data storage area must be set up ... [so] the system prompts the golfer to input personal information including name, address, [etc.], ... [and] also prompts the golfer to input a PIN number, ... [all of which is stored in] a storage information area ... for the golfer ..., [and then] the system will issue the golfer an identification card for automatic access to the system. The system will charge the new golfer's account for any set up costs and user's fees incurred in setting up the account. The golfer will have an opportunity to pay this amount and even add money to his identification/debit card if he so desires in the payment mode

"If the golfer has used the system before, the golfer only has to insert his identification card or enter his personal identification number to access the system. The ... golfer can select ... a payment mode ... (Fig. 7), [in which] the

system first informs the golfer of the charges for setting up the account and use of the system, ... requests the golfer to indicate the items for which payment is being made, ... including greens fees, system fees, club house meals, pro shop items and services such as caddies and lessons. ... The system will display each of the items and their costs along with a total cost ..., and inquire if the golfer approves If the list is incorrect, the ... golfer [is allowed] to correct ... [it, and/or if] correct, ... the golfer [is prompted] to select a method of payment, ... including credit card, debit card, automatic bank teller machine card, cash, or bill it to a personal account.

* * * * *

“If ... cash [is used], ... the system will prompt the golfer to insert ... [it] into a conventional cash receiving device, ... [and] if sufficient cash is inserted, the transaction is completed, change is returned, and a receipt is printed.... If [instead,] the user elects to bill the charges to a personal account, ... the system prompts the user to input an account identification in the form of a PIN number or a password....”

Appellant submits that it is abundantly clear from these passages, that the Germain disclosure is far afield from a teaching of “similar matter” (ascribed to it by examiner) to that of the method disclosed and claimed in claims 1-7. In fact, the operation described in cols. 11 and 12 and shown in Figs. 6 and 7 of Germain appears to handle payment in a very conventional manner, automating only the manual actions of a human cashier, and in any case, is not Germain’s invention. More importantly, it is quite apparent that Germain lacks any suggestion of invoking or establishing a gratis trial period, or automatically rendering the cart-based information and display system inactive if payment is not authorized by the end of the trial period, as called for by appellant’s claim 1. Indeed, the examiner admits that “Germain does not specifically teach providing a gratis trial period „, for the player” (or even generally, or deactivating the system thereafter absent payment). And in addition to the fact that it would not lead to the method and system claimed by appellant, an attempt to combine Germain with Fisher would appear to defeat the purpose of the Fisher system, by replacing Fisher’s analytical techniques with a considerably more cumbersome recording card storage and retrieval system.

The examiner’s citation of Fano regarding stock quotations and email is submitted to be of no real consequence since here again, the recital of those elements is merely intended by appellant to set forth the environment in which the method of the invention claimed in claim 1 (and each of its dependent claims 2-5) is used.

In the Final Action, the examiner purported to respond to appellant’s arguments (presented in reply to the rejections set forth in the first Action, which rejections were repeated without substantive change in the Final Action), by asserting that: “In this case, providing free trials for potential customers is [a] commonly used approach for companies to promote their products or

services to the potential customers. Thus, examiner believes the rejections are proper.”

Appellant submits, however, that the method claimed in claims 1-5 (and in the other method claims and apparatus claims on appeal here) does not involve such “commonly used approach.” In the first place, there is no relationship here to a “free sample” as might be offered in the marketing of an inexpensive product to woo customers, nor a “free trial” for a day as might be offered by a physical fitness gym to convince a prospective customer to sign a contract, or even a free round of golf to entice a golfer to join a golf club. Rather, appellant’s invention resides not merely in invoking or establishing a *gratis* trial *period*, which exists while the user (the golfer) is engaged in the actual play of a round -- but not a complete round -- but in a method and means to end that *period* or to allow the use of the cart-based system for the remainder of play of the round, based on an election by the golfer/user of the cart, and a method and means to accommodate that election through an acceptable payment authorization before the *period* expires.

This is not the stuff of which “commonly used approaches of simply offering free trials for potential customers” are made. Rather, it is submitted that what the examiner has sought to do here is a direct violation of the mandate that, to establish a *prima facie* case of obviousness, “*the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.*” That attempt is exemplified by examiner’s selection of references clearly based on appellant’s own disclosure, references that examiner ultimately admits fail to teach the essence of appellant’s invention but nevertheless contends “it just seems to be obvious.”

Accordingly, appellant further submits that claim 1 is patentable over the references of record as applied by the examiner; and that the rejection of claim 1 is without merit, and should be reversed.

(ii) With respect to claim 2

The same argument as presented above with respect to claim 1 applies equally to its dependent claim 2. Additionally, claim 2 recites “the step of providing the golfer with a capability to enter a payment authorization during or at the end of said *gratis* trial period.” This step is also not found or suggested in the references of record, notwithstanding that Germain may disclose a technique for providing a golfer with a capability to enter a payment authorization PERIOD. The context and the coverage are completely different. Accordingly, appellant submits that claim 2 is patentable over the references of record as applied by the examiner; and that the rejection of claim 2 is without merit, and should be reversed.

(iii) With respect to claim 3

The same arguments as presented above with respect to claims 1 and 2 apply equally to their dependent claim 3. Additionally, claim 3 recites that “said step of providing a capability to enter payment authorization comprises outfitting the cart with said capability.” This step is also not found or suggested in the references of record, and further Germain doesn’t disclose outfitting a cart with such capability for any purpose. In any event, here again, the context and the coverage are completely different. Accordingly, appellant submits that claim 3 is patentable over the references of record as applied by the examiner; and that the rejection of claim 3 is without merit, and should be reversed.

(iv) With respect to claim 4

The same arguments as presented above with respect to claims 1 and 2 apply equally to their dependent claim 4. Additionally, claim 4 recites that “said step of providing a capability to enter payment authorization comprises locating a kiosk outfitted with said capability at a point of play to be traversed by the cart during or at the end of said gratis trial period.” This step is also not found or suggested in the references of record, and further Germain doesn’t disclose outfitting a kiosk with such capability for any purpose at any point along a cart path, gratis trial period or not. In any event, here again, the context and the coverage are completely different. Accordingly, appellant submits that claim 4 is patentable over the references of record as applied by the examiner; and that the rejection of claim 4 is without merit, and should be reversed.

(v) With respect to claim 5

The same arguments as presented above with respect to claims 1 and 2 apply equally to their dependent claim 5. Additionally, claim 5 recites that “said capability comprises at least one of a credit, debit or smart card reader, a paper currency reader, a keypad, a touch sensitive screen, an optical scanner, a magnetic scanner, and a wireless communicator.” This capability in the context of the parent claims is also not found or suggested in the references of record, whatever else Germain may disclose regarding payment authorization entry means. In any event, here again, the context and the coverage are completely different. Accordingly, appellant submits that claim 5 is patentable over the references of record as applied by the examiner; and that the rejection of claim 5 is without merit, and should be reversed.

(vi) With respect to claim 6

The same argument as presented above with respect to claim 1 applies equally to independent method claim 6, whose rejection is stated by the examiner to be “for the similar reason as claim 1.” Claim 6 differs substantively from claim 1, in that the cart display of information is enabled for the gratis trial period rather than activated, and said cart display of such

information is disabled at the end of said gratis trial period unless, by that point of play, an act representing commitment of payment for completion of the round with enabled cart display has been detected, rather than as required by claim 1, automatically rendering said cart display of such information inactive at the end of said gratis trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made. Accordingly, appellant submits that claim 6 is patentable over the references of record as applied by the examiner; and that the rejection of claim 6 is without merit, and should be reversed.

(vii) With respect to claim 7

The same argument as presented above with respect to claim 1 applies equally to independent method claim 7, whose rejection is stated by the examiner to be “for the similar reason as claim 1.” Claim 7 differs substantively from claim 1, in automatically maintaining said cart display of the information active for completion of the round if, by the end of said gratis trial period, a commitment of payment therefor has been made, rather than as required by claim 1, automatically rendering said cart display of such information inactive at the end of said gratis trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made. Accordingly, appellant submits that claim 7 is patentable over the references of record as applied by the examiner; and that the rejection of claim 7 is without merit, and should be reversed.

(2) Final rejection of claims 8-11 under 35 U.S.C. 103(a).

(i) With respect to claim 8

The same argument as presented above with respect to claim 1 applies equally to independent method claim 8, which was rejected on the grounds that “all the limitations [of that claim] are taught by Fisher modified by Germain as discussed in claim 1.” Claim 8 differs substantively from claim 1, in more generally claiming a method for administering use of an information system implemented in golf carts adapted to provide access to information available through said system to persons using the carts during play of a golf course, comprising the steps of establishing a trial period at the start of play with a cart, less than an entire round of play of the golf course, during which at least the bulk of said information is available for access by the cart user, and ending access to said available information by the cart user at the end of said trial period absent a payment authorization for continued access during play of the round.

It is clear, however, that the essence of the argument presented in support of the patentability of claim 1 is valid in its entirety here as well. Accordingly, appellant submits that claim 8 is patentable over the references of record as applied by the examiner; and that the rejection of claim 8 is without merit, and should be reversed.

(ii) With respect to claim 9

The same argument as presented above with respect to claim 1 applies equally to independent apparatus claim 9, which was rejected on the grounds that “all the limitations [of that claim] are taught by Fisher modified by Germain as discussed in claim 1.” Claim 9 differs substantively from claim 1, in claiming apparatus for administering use of an information system implemented in golf carts adapted to provide access to information available through said system to persons using the carts during play of a golf course, comprising said cart-implemented information system automatically establishing a trial period at the start of play of a round of golf with a cart on said golf course, less than an entire round, during which substantially all of said information is available for access by the cart user, and entry means for detecting payment authorization by the end of said trial period for enabling continued access to said available information beyond the end of said trial period. Thus, claim 9 may be regarded as an apparatus claim counterpart of method claim 8.

It is clear, then, that the essence of the argument presented in support of the patentability of claim 1 is valid in its entirety here as well. Accordingly, appellant submits that claim 9 is patentable over the references of record as applied by the examiner; and that the rejection of claim 9 is without merit, and should be reversed.

(iii) With respect to claim 10

The same argument as presented above with respect to claim 1 applies equally to independent method claim 10, which was rejected on the grounds that “all the limitations [of that claim] are taught by Fisher modified by Germain as discussed in claim 1.” Claim 10 differs substantively from claim 1, in claiming a method of controlling the availability of information presented to a user of a golf course mobile navigation system from within the system during play of the course, wherein at least some of said information is presented relative to the real-time position of the system as it traverses the course, to enhance play, comprising the steps of providing a gratis trial period for full availability of said information to the user on commencing use of the system, less than an entire round of play of the course, and automatically curtailing the amount of said information available to the user at the end of said trial period, unless payment authorization is given for continued full availability thereafter.

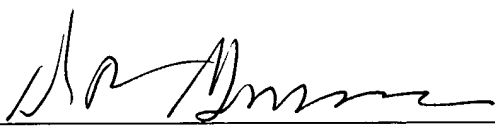
It is clear, however, that the essence of the argument presented in support of the patentability of claim 1 is valid in its entirety here as well. Accordingly, appellant submits that claim 10 is patentable over the references of record as applied by the examiner; and that the rejection of claim 10 is without merit, and should be reversed.

(iv) With respect to claim 11

The same argument as presented above with respect to claim 1 applies equally to independent apparatus claim 11, which was rejected on the grounds that "all the limitations [of that claim] are taught by Fisher modified by Germain as discussed in claim 1." Claim 11 differs substantively from claim 1, in claiming apparatus for controlling the availability of information presented to a user of a golf course mobile navigation system from within the system during play of the course, wherein at least some of said information is presented relative to the real-time position of the system as it traverses the course, to enhance play, said apparatus comprising means adapted to implement a trial period for full availability of said information to the user on commencing use of the system, less than an entire round of play of the course, and means responsive to completion of said trial period without a commitment to pay for continued full availability of said information in further play of the round, for automatically curtailing the amount of said information available to the user from the system thereafter. Thus, claim 11 may be regarded as an apparatus claim counterpart of method claim 10.

It is clear, then, that the essence of the argument presented in support of the patentability of claim 1 is valid in its entirety here as well. Accordingly, appellant submits that claim 11 is patentable over the references of record as applied by the examiner; and that the rejection of claim 11 is without merit, and should be reversed.

Respectfully submitted,
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iii) Claims appendix

1 1. (previously presented) A method for administering use of a golf course information
2 system implemented in golf carts or other roving units with display monitor adapted to provide
3 display of any or all information from among course and hole layout, course features and distance
4 to assist a golfer in play of the golf course, or of specific interest to the individual from external
5 networks including tournament and individual scoring, stock quotations and electronic mail to
6 enhance the golfing experience, said method comprising the steps of:

7 invoking a gratis trial period less than an entire round of play of the course during which
8 the cart display of such information is activated for a golfer commencing use of the cart; and

9 automatically rendering said cart display of such information inactive at the end of said
10 gratis trial period unless, by that point of play, a payment authorization for completion of the
11 round with activated cart display has been made by a golfer using the cart.

1 2. (original) The method of claim 1, including the step of providing the golfer with a
2 capability to enter a payment authorization during or at the end of said gratis trial period.

1 3. (original) The method of claim 2, wherein said step of providing a capability to enter
2 payment authorization comprises outfitting the cart with said capability.

1 4. (original) The method of claim 2, wherein said step of providing a capability to enter
2 payment authorization comprises locating a kiosk outfitted with said capability at a point of play
3 to be traversed by the cart during or at the end of said gratis trial period.

1 5. (original) The method of claim 2, wherein said capability comprises at least one of
2 a credit, debit or smart card reader, a paper currency reader, a keypad, a touch sensitive screen,
3 an optical scanner, a magnetic scanner, and a wireless communicator.

1 6. (previously presented) A method for administering use of a golf course information
2 system implemented in golf carts or other roving units with display monitor adapted to provide
3 display of any or all information from among course and hole layout, course features and distance
4 to assist a golfer in play of the golf course, or of specific interest to the individual from external
5 networks including tournament and individual scoring, stock quotations and electronic mail to
6 enhance the golfing experience, said method comprising the steps of:

7 establishing a gratis trial period less than an entire round of play of the course during
8 which the cart display of such information is enabled for a golfer using the cart; and
9 disabling said cart display of such information at the end of said gratis trial period unless,
10 by that point of play, an act representing commitment of payment for completion of the round
11 with enabled cart display has been detected.

1 7. (previously presented) A method for administering use of a golf course information
2 system implemented in golf carts or other roving units with display monitor adapted to provide
3 display of any or all information from among course and hole layout, course features and distance
4 to assist a golfer in play of the golf course, or of specific interest to the individual from external
5 networks including tournament and individual scoring, stock quotations and electronic mail to
6 enhance the golfing experience, said method comprising the steps of:

7 invoking a gratis trial period less than an entire round of play of the course during which
8 the cart display of such information is activated for a golfer commencing use of the cart; and
9 automatically maintaining said cart display of such information active for completion of
10 the round if, by the end of said gratis trial period, a commitment of payment therefor has been
11 made by a golfer using the cart.

1 8. (original) A method for administering use of an information system implemented in
2 golf carts adapted to provide access to information available through said system to persons using
3 the carts during play of a golf course, said method comprising the steps of:

4 establishing a trial period at the start of play with a cart, less than an entire round of play
5 of the golf course, during which at least the bulk of said information is available for access by the
6 cart user, and

7 ending access to said available information by the cart user at the end of said trial period
8 absent a payment authorization for continued access during play of the round.

1 9. (original) Apparatus for administering use of an information system implemented in
2 golf carts adapted to provide access to information available through said system to persons using
3 the carts during play of a golf course, comprising:

4 said cart-implemented information system automatically establishing a trial period at the
5 start of play of a round of golf with a cart on said golf course, less than an entire round, during
6 which substantially all of said information is available for access by the cart user, and

7 entry means for detecting payment authorization by the end of said trial period for

8 enabling continued access to said available information beyond the end of said trial period.

1 **10.** (previously presented) A method of controlling the availability of information
2 presented to a user of a golf course mobile navigation system from within the system during play
3 of the course, wherein at least some of said information is presented relative to the real-time
4 position of the system as it traverses the course, to enhance play, said method comprising the
5 steps of:

6 providing a gratis trial period for full availability of said information to the user on
7 commencing use of the system, less than an entire round of play of the course, and

8 automatically curtailing the amount of said information available to the user at the end of
9 said trial period, unless payment authorization is given for continued full availability thereafter.

1 **11.** (previously presented) Apparatus for controlling the availability of information
2 presented to a user of a golf course mobile navigation system from within the system during play
3 of the course, wherein at least some of said information is presented relative to the real-time
4 position of the system as it traverses the course, to enhance play, said apparatus comprising:

5 means adapted to implement a trial period for full availability of said information to the
6 user on commencing use of the system, less than an entire round of play of the course, and

7 means responsive to completion of said trial period without a commitment to pay for
8 continued full availability of said information in further play of the round, for automatically
9 curtailing the amount of said information available to the user from the system thereafter.

(ix) Evidence appendix

None

(x) Related proceedings appendix

None